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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,529	07/16/2003	Lukas Eisermann	4002-3359/PC635.02	8968

52196 7590 05/11/2006

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EXAMINER	
BAXTER, JESSICA R	

ART UNIT	PAPER NUMBER
3733	

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/620,529	EISERMANN ET AL.	
	Examiner	Art Unit	
	Jessica R. Baxter	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-50 and 61-80* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-50 and 61-80* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *16 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12152005,07162003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 41-50, 61-80 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-40 of U.S. Patent No. 6,740,118. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim first and second articular components with bearing surfaces, wherein at least one of the bearing surfaces has a flange, and wherein one of the articular surfaces has a depression.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 41-44, 48, 49, 73, and 76 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 01/01893 to Marnay et al.

Marnay discloses an intervertebral prosthetic joint comprising a first bearing surface (5) adapted to engage a first vertebra; a second bearing surface (13) adapted to engage a second vertebra; a flange (7, 6, 14) projecting from each of said bearing surfaces, said flange having a length extending along said at least one bearing surface and a width tapering in a direction along at least a portion of said length (FIG. 2); wherein said edge has a leading insertion end defining a beveled edge (FIG. 2); further comprising first and second articular surfaces (12,25) cooperating to provide articular motion (FIG. 7).

5. Claims 41-46,48, 73 and 74 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,592,624 to Fraser et al.

Fraser discloses an intervertebral prosthetic joint comprising a first bearing surface adapted to engage a first vertebra; a second bearing surface adapted to engage a second vertebra (FIG. 10); a flange (18) projecting from each of said bearing surfaces, said flange having a length extending along said at least one bearing surface and a width tapering in a direction along at least a portion of said length (FIG. 3A); wherein said edge has a leading insertion end defining a beveled edge *Column 3, lines 49-61); further comprising a bone-growth promoting substance to facilitate bone on-growth (Column 3, lines 43-48).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 41-44, 48-50, 73,74, 76, 77, 79, and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,113,637 to Gill et al. in view of Fraser et al '624.

Gill discloses a intervertebral prosthetic joint comprising a first bearing surface (32) adapted to engage a first vertebra; a second bearing surface (54) adapted to engage a second vertebra; further comprising first and second articular surfaces (30, 50) cooperating to provide articular motion; wherein at least one of said first and second articular surfaces includes at least one surface depression (52). Gill discloses the claimed invention except for the flange projecting from at least one of said bearing surfaces. Fraser teaches that flanges are utilized to enhance secure implantation of the implant and prevent expulsion of the implant from its implantation location (Column 3 , lines 43-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Gill with the flanges of Fraser in order to provide a more secure implantation of the implant and prevent expulsion of the implant.

8. Claims 61, 62, 64, 66, 67, 69, 70, 71, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser et al. '624 in view of U.S. Patent No. 6,743,256 to Mason.

Fraser discloses the claimed invention except for the an opening extending partially therethrough. Mason teaches that partial openings or depressions facilitate fusion of an

implant to bone by increasing the surface area of the implant (Column 2, lines 52-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Fraser with an opening extending partially therethrough in order to facilitate fusion of the implant to the bone.

9. Claims 61, 62, 65 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill et al. '637 in view of Fraser et al. '624, as applied above, further in view of Mason '256.

Gill, as modified, discloses the claimed invention except for the an opening extending partially therethrough. Mason teaches that partial openings or depressions facilitate fusion of an implant to bone by increasing the surface area of the implant (Column 2, lines 52-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Gill, as modified, with an opening extending partially therethrough in order to facilitate fusion of the implant to the bone.

10. Claims 66, 67, 69, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marney et al. '893 in view of Mason '256.

Marnay discloses the claimed invention except for the an opening extending partially therethrough. Mason teaches that partial openings or depressions facilitate fusion of an implant to bone by increasing the surface area of the implant (Column 2, lines 52-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Marnay with an opening extending partially therethrough in order to facilitate fusion of the implant to the bone.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R. Baxter whose telephone number is 571-272-4691. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica R Baxter
Examiner
Art Unit 3733

jrb

EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER